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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/834,167 04/12/01 KAVANAUGH

P 42270/PYI/X3

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TM02/1003

EXAMINER

PARK, J	
ART UNIT	PAPER NUMBER

2182
DATE MAILED:

10/03/01

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

10

Office Action Summary

Application No.

09/834,167

Applicant(s)

KAVANAUGH ET AL.

Examiner

Ilwoo Park

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18 and 24 drawn to an invention directed to a peripheral adapting, classified in class 710, subclass 72.
 - II. Claim 25 drawn to an invention directed to a computer power control, classified in class 713, subclass 300.
2. During a telephone conversation with Michael J. Bolan on 9/24/2001, an election was made without traverse to prosecute the invention of elected group I, claims 1-18 and 24. Claim 25 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.
3. Claims 1-18 and 24 are presented for examination.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 6 recites the limitation "said touch-sensitive display device" and "said control data" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1, 7, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Steere, Jr. et al. (Steere), US patent No. 5,848,298.

As to claim 1, Steere teaches a wallet (fig. 9; col. 1, lines 33-34) for use with a personal information device (PCMCIA card; col. 1, lines 23-27), said wallet comprising:

a first portion (col. 8, lines 23-42) including an input device (col. 4, lines 15-19) for receiving a user-supplied entry; and

a second portion (col. 8, lines 43-60) rotatably coupled to said first portion, said second portion being adapted to receive and detachably retain a personal information device (PCMCIA card; col. 1, lines 23-27) in the form of a PCMCIA card, said second portion including supply means electrically coupled to said input device and being adapted to communicate with said personal information device.

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8. As to claim 7, Steere teaches the supply means is a PCMCIA port (col. 7, lines 64-66) adapted to be coupled to a PCMCIA I/O port of said personal information device when said wallet receives said personal information device.

9. As to claim 12, Steere teaches a wallet (fig. 9; col. 1, lines 33-34) in combination with a personal information device (PCMCIA card; col. 1, lines 23-27), the combination comprising:

a wallet first portion (col. 8, lines 23-42) including an input device (col. 4, lines 15-19) for receiving a user-supplied entry;

a wallet second portion (col. 8, lines 43-60) rotatably coupled to said first portion, said wallet second portion being adapted to receive and detachably retain a PCMCIA card (PCMCIA card; col. 1, lines 23-27);

a personal information device in the form of a PCMCIA card, said personal information device detachably retained in said wallet second portion, said personal information device including:

a display (touch screen LCD display) for displaying information to the user;

an input device for receiving (col. 6, lines 21-54) a user-supplied input; and

input means for receiving (col. 8, lines 1-5) data from said wallet when said personal information device is retained therein,

and said wallet second portion includes output means for providing said user-supplied entry as an output of said wallet to said input means of said personal information device.

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 5, 6, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steere, Jr. et al. (Steere), US patent No. 5,848,298.

As to claims 2 and 15, Though Steere teaches the input device is a touch screen in the form of a keyboard, Steere does not teach the input device is a touch pad in the form of a keyboard. However, a touch pad is well known in the art of input device in the form of a keyboard.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to use a touch pad instead of using a touch screen for a simpler design in software of the wallet.

12. As to claim 5, Steere teaches said input device is a touch-sensitive display device (col. 6, lines 22-31) operable to display information to the user, and said supply means is operable to receive from said personal information device control data, and said touch-sensitive display device provides a display to said user in accordance with said control data (implicit; col. 8, lines 1-5).

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13. As to claim 6, Steere teaches a memory having pre-stored sets of display data (col. 6, lines 22-24) and the touch-sensitive display device displayable corresponding one of pre-stored sets of display data identified by a control data (implicit; col. 6, lines 22-41 and col. 8, lines 1-5).

14. As to claim 8, Steere does not teach both of first and second portions are accessible to the user in an open position of the wallet and neither of first nor second portions are not accessible to the user in closed position of the wallet (col. 7, lines 59-64 and col. 8, lines 9-11); however, the accessibility in the claimed invention is well known in the art.

15. Claims 3, 9-11, 13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steere, Jr. et al. (Steere), US patent No. 5,848,298 as applied to claims 1 and 12 above, and further in view of Gee et al. (Gee), US patent No. 5,619,396.

As to claims 3 and 13, Gee teaches electrical contacts adapted to contact opposing surfaces (fig. 1).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Steere and Gee because they both teach two portions electrically coupled through supply means for a PCMCIA communication and the Gee's teaching of electrical contacts adapted to contact opposing surfaces would increase flexibility by having a host computer connectivity (Gee; col. 3, lines 44-47).

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16. As to claims 9 and 16, Gee teaches an I/O connector adapted to be coupled via cable to an external device, said I/O connector being electrically connected to said supply means and being adapted to provide data supplied from said external device to said supply means, and said supply means is adapted to supply said data supplied thereto including data supplied from external device to said personal information device (col. 3, lines 44-59).

17. As to claim 10, Gee teaches the external device is a computer (col. 3, lines 44-47).

18. As to claim 11, Steere teaches a communication between two personal information devices is possible (col. 5, lines 31-35; col. 8, lines 1-5).

19. Claims 4, 14, 17, 18, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steere, Jr. et al. (Steere), US patent No. 5,848,298 in view of Ohdake et al. (Ohdake), US patent No. 5,594,680.

As to claims 4 and 14, Ohdake teaches an induction coil for communication without electrical contact (abstract) for interfacing a PCMCIA card (col. 8, lines 1-5).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Steere and Ohdake because they both teach a supply means interfacing a PCMCIA card and the Ohdake's teaching of an induction coil for communication

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without electrical contact would increase reliability of Steere's communication with the personal information device.

20. As to claim 17, Steere teaches a wallet in combination with a personal information device (PCMCIA card; col. 1, lines 23-27), the combination comprising:

a personal information device having a display and an input device (col. 6, lines 21-54);
and

a wallet (col. 8, lines 23-42) having an input device (col. 4, lines 15-19), said wallet being adapted to receive and detachably retain said personal information device.

However, Steere does not teach an induction coil in a personal information device and in a wallet adapted to communicate with each other without electrical contact.

Ohdake teaches an induction coil for communication without electrical contact (abstract) for interfacing a PCMCIA card (col. 8, lines 1-5).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Steere and Ohdake because they both teach a supply means interfacing a PCMCIA card and the Ohdake's teaching of an induction coil for communication without electrical contact would increase reliability of Steere's communication with the personal information device.

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21. As to claim 18, Steere teaches the personal information device is a PCMCIA card adapted to connect to a PCMCIA port of a device (PCMCIA card; col. 1, lines 23-27).

22. As to claim 24, Steere teaches a wallet first portion having said input device for receiving a user-supplied entry and a wallet second portion rotatably coupled to said wallet first portion, said wallet second portion being adapted to receive and detachably retain said personal information device (col. 8, line 18-col. 10).

Conclusion

23. Any inquiry concerning this communication should be directed to Ilwoo Park, whose telephone number is (703) 308-7811 or via E-mail, *ilwoo.park@uspto.gov*. The Examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Thomas C. Lee, can be reached at (703) 305-9717.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

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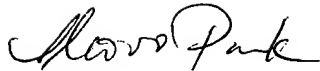
(703) 308-9051 (for formal communications intended for entry)

or:

(703)305-3718 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).



Ilwoo Park

September 26, 2001



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